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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,389	10/14/2008	Ram Srivats	04-40395-US	2991
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REED SMITH LLP 2500 ONE LIBERTY PLACE 1650 MARKET STREET PHILADELPHIA, PA 19103			EXAMINER BELLINGER, JASON R	
			ART UNIT	PAPER NUMBER
			3617	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/585,389

**Applicant(s)**

SRIVATS ET AL.

**Examiner**

JASON R. BELLINGER

**Art Unit**

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_

***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in a foreign country on 7 January 2004. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

***Drawings***

2. Figures 1-8 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to because Figures 1-15 all lack reference characters. Furthermore, reference character 1 does not appear to indicate a "gutter" as described in the specification. Instead, reference character 1 appears to indicate a flange.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement

sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In this case, the drawings do not show how a tire could be mounted on the wheel rim, given the fact that only a single bead seat and rim flange are shown.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the wheel having a tire mounted thereon, as set forth in claim 13, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. The abstract of the disclosure is objected to because it is a copy of the first page of the PCT, which is improper (see below). Correction is required. See MPEP § 608.01(b).

7. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:  
(1) if a machine or apparatus, its organization and operation;

- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

8. The disclosure is objected to because of the following informalities: Paragraph [0009] should be relocated to the first page of the specification and renumbered as paragraph [0001], to properly indicate claims of priority.

Appropriate correction is required.

### ***Claim Objections***

9. Claims 3-5, 7, 29, 31, 36, and 40 are objected to because of the following informalities: The comma (,) following the term "with" in line 2 of claims 3-4 and 7 should be removed.

The term "taper" should be replaced with the term --tapered-- in claims 4-5.

Claim 29 is objected to for including a period (.) at the end of sections (d) and (e); making it unclear whether the limitations set forth in sections (e) and (f) are actually part of claim 29. Furthermore, a comma (,) should be inserted following the term "diameter" in line 7 of section (e) of claim 29. The term "preformed" should be replaced with the term --performed-- in line 10 of section (e) of claim 29. The term "of" should be replaced with the term --the-- in line 15 of section (e) of claim 29. The term "perform" should be replaced with the term --preform-- in line 5 of section (f) of claim 29. The phrase

"comprise of a inboard" should be replaced with the phrase --comprises an inboard-- in line 7 of section (f) of claim 29.

In line 3 of claim 31, the term "perform" should be replaced with the term --preform--.

The term --An-- should be inserted prior to the term "apparatus" in line 1 of claims 40-41. A Comma (,) should be inserted following the term "flange" in line 4 and the term "blank" in line 6 of claim 40.

These corrections are for grammatical clarity. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

**10.** The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**11.** Claims 2, 16, 29-44, and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 is indefinite due to the fact that it is unclear what is actually being claimed by the phrases "the forward direction" and "the backward direction". No directional indicators (i.e. axial, radial, etc.) have been provided to clearly define these limitations. Furthermore, no datum or base point has been defined with reference to these directions.

Claim 29 is further indefinite due to the fact that it is unclear what is actually being claimed by the phrase "formed in the subsequent operations". Each step of the



method set forth in claim 29 is denoted by a lettered bullet (i.e. "a.", "b.", etc.). The aforementioned phrase seems to indicate the presence of substeps, which are not set forth in the claim.

Claims 30 and 32 are indefinite due to the fact that it is unclear what element is being referred to by the phrase "the same".

Claims 35-36 and 40 are indefinite due to the fact that it is unclear what is actually being claimed by the limitation of a "conventional press". The term "conventional" is a relative term, not sufficiently defined in the specification. The metes and bounds of this term cannot be determined, given the fact that a multitude of presses having different configurations exist in the art.

Claim 41 is indefinite due to the fact that it is unclear what is actually being claimed. Namely, claim 41 sets forth an "apparatus for manufacturing" and the last line of the claim states "manufactured by the process claimed in claim 1". However, it should be noted that claim 1 sets forth a wheel, which is a product, and not a method. Therefore, the metes and bounds of this claim cannot be determined.

Claim 42 is indefinite due to the fact that it is unclear what is actually being claimed by the phrase "when spin forming machine is programmed to form different shapes".

**12.** Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled

in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "gutter" in claims 2, 16, 29, 40-44, and 47 is used by the claim to mean "projection" or "flange" (as best understood from the drawings), while the accepted meaning is "a trough or groove to catch and direct something." The term is indefinite because the specification does not clearly redefine the term.

13. Regarding claim 29, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

14. Claim 34 recites the limitation "said first-name spin forming step" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. This limitation has not been previously set forth in the claims.

15. Claims 42-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. These claims are omnibus type claims.

#### ***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

17. Claims 1-4, 6-9, 11-19, 21-23, 25-28, 30-39, 45-48, and 50-51 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Jurus ('810). Jurus discloses the inventions as set forth in the above claims.

18. Claims 1-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Srivats.

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this

application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Strivats discloses the inventions set forth in the above claims.

***Claim Rejections - 35 USC § 103***

**19.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**20.** Claims 5, 20, 29, 40-44, and 49 rejected under 35 U.S.C. 103(a) as being unpatentable over Jurus ('810) in view of Ashley, Jr. et al (hereafter Ashley).

Jurus does not disclose the angle of the bead seats or drop center rim portion. Ashley teaches the formation of a wheel having a 5 degree central rim portion and bead seats. Therefore, from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the wheel of Jurus with 5 degree bead seats and drop center rim, to predictably decrease the amount of effort required to mount a tire thereon.

**21.** Claims 10 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jurus ('810) in view of Beyer. Jurus does not disclose vent holes formed in the disc portion of the wheel.

Beyer teaches the formation of a wheel having vent and/or decorative holes 27 formed in the disc portion of a wheel. Therefore, from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form vent holes in the disc wheel of Jurus, in order to allow airflow to reach the brake components of the vehicle and/or to enhance the aesthetic appearance of the wheel.

### ***Double Patenting***

**22.** The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**23.** Claims 1-51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No. 10/585,468. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are fully encompassed by the copending claims. Therefore, it is obvious that the Applicant is claiming the same invention in different terms.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON R. BELLINGER whose telephone number is (571)272-6680. The examiner can normally be reached on Mon - Thurs (9:00-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason R Bellinger/  
Primary Examiner  
Art Unit 3617